

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

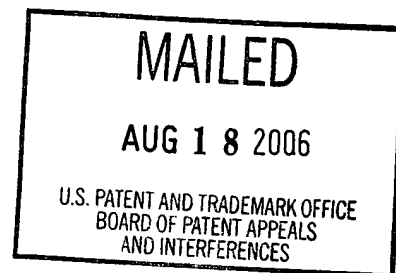
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PATRICK H. HAYES and ROBERT A. CAMPBELL

Appeal No. 2006-1995
Application No. 10/662,263

ON BRIEF



Before KRASS, RUGGIERO, and HOMERE, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-10, which are all of the claims pending in this application. Claims 11-19 have been canceled.

The claimed invention relates to a system for programming a remote control using a readable media such as a smart card which has code data stored thereon. The code data is readable by the remote control enabling the remote control to command a home appliance to perform an operation. Also stored on the readable media is access data which is modifiable by the remote control to limit the ability of the remote control to use the code data stored on the readable media.

Claim 1 is illustrative of the invention and reads as follows:

1. A system for programming a remote control, comprising:

a readable media having electrical contacts for allowing the readable media to be releasably connected to the remote control, the readable media having stored thereon code data where the remote control is adapted to read the code data from the readable media and thereafter use the code data in connection with commanding a first home appliance to perform an operation and wherein the readable media has stored thereon access data that is modifiable by the remote control for the purpose of limiting use of the code data.

The Examiner relies on the following prior art:

Renner et al. (Renner)	5,679,945	Oct. 21, 1997 (filed Mar. 31, 1995)
Parienti et al. (Parienti) (published international patent application).	WO 9409570	Apr. 28, 1994

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Claims 1-10 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Parienti and Renner.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-10. Accordingly, we reverse.

¹ The Appeal Brief was filed January 17, 2006. In response to the Examiner's Answer mailed March 8, 2006, a Reply Brief was filed March 29, 2006, which was acknowledged and entered by the Examiner as indicated in the communication dated April 11, 2006.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience – or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's

conclusion. These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claim 1 based on the combination of Parienti and Renner, Appellants assert (Brief, pages 7 and 8; Reply Brief, pages 3 and 4) that the Examiner has failed to set forth a prima facie case of obviousness since proper motivation for the proposed combination of references has not been established. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

The Examiner proposes (Answer, page 4) to modify the programmable remote control device of Parienti by adding the intelligent card reader device of Renner. In our view, however, the system described by Renner has little relevance to the remote control device of Parienti and, at best, provides only a disclosure that intelligent card readers that may be adapted to read various forms of smart cards are known in the art. We find no convincing rationale provided by the Examiner as to why the ordinarily skilled artisan would look to the teachings of Renner, directed to intelligent card readers for providing access to parking garages, locks, and vending machines, to solve problems associated with smart card programmable remote control devices which in turn function to operate home appliances as claimed. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.

We are further of the view that even assuming, arguendo, that proper motivation existed for the Examiner's proposed modification of Parienti with Renner, the ensuing result would not satisfy the specific combination set forth in independent claim 1. We agree with Appellants that the passage of Renner beginning at column 13, line 30 cited by the Examiner does not support the Examiner's conclusion that Renner provides for a smart card having access data which is modifiable by a device which reads the card as claimed. Our review of the cited portion of Renner reveals that, at best, there is only a disclosure that the smart card has a transaction counter which keeps track of the total number of transactions. Any conclusion that such transaction counter may be accessed and modified by the intelligent card reader, as asserted by the Examiner, can only be based, in our view, on unwarranted and unsupported speculation.

In view of the above discussion, since we are of the opinion that the proposed combination of the Parienti and Renner references set forth by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claim 1, nor of claims 2-10 dependent thereon.

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In summary, we have not sustained the Examiner's rejections of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-10 under 35 U.S.C. § 103(a) is reversed.

REVERSED

En M. K.

ERROL A. KRASS
Administrative Patent Judge

Joseph F. Ruggie
JOSEPH F. RUGGIE

JOSEPH F. RUGGIERO
Administrative Patent Judge

Jean R. Homere

JEAN R. HOMERE
Administrative Patent Judge

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GREENBERG TRAURIG, LLP
77 WEST WACKER DRIVE
SUITE 2500
CHICAGO, IL 60601-1732